

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

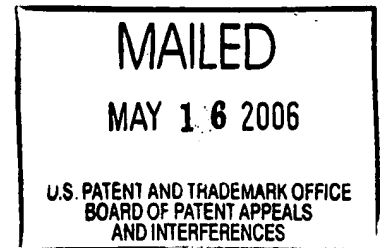
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. MANN

Appeal No. 2006-1105
Application 10/643,626

ON BRIEF



Before PAK, WALTZ and TIMM, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 12 through 14 and 16 (see the amendment dated Apr. 29, 2005, subsequent to the final Office action, which was entered as noted in the Advisory Action mailed May 9, 2005; see also the Brief, page 2). Claims 2, 4-9, 19 and 23-27 have been allowed by the examiner, while the examiner has objected to claims 15 and 17 as depending on a rejected base claim, but would be allowable if rewritten in independent form including the base claim and any intervening claims (Brief, page 2). No other

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claims are pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a paint roller grid 1 sized for mounting in a container 14 to aid in dispersing paint more evenly over a paint roller cover 34 sized to be immersed in a supply of paint in the container and then rolled along a wiping surface 2 of the grid (Brief, pages 2-3). Surrounding the wiping surface 2 is a frame 4 having upper and lower ends 5,6 and opposite sides 7,8 with rearwardly protruding laterally spaced hooks from opposite side edges 9,10 for hooking over the upper rim 13 of the container 14, while laterally spaced feet 25,26 are rigidly affixed to the bottom edge of the grid frame 4 to prevent the grid from moving within the container 14 (Brief, page 3). Illustrative independent claim 12 is reproduced below:

12. A paint roller grid comprising a wiping surface for wiping a roller cover against the wiping surface, a frame extending completely around the wiping surface, at least one hook extending rearwardly from the frame for hooking over an upper rim of a cylindrical container when the grid is inserted into a top opening of the container, and a pair of laterally spaced feet extending rearwardly from a bottom edge of the frame for engagement with an inner cylindrical surface of the container to prevent the grid from moving within the container during rolling of a roller cover on the wiping surface.

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The examiner has relied on the following references as evidence of obviousness:

Welt	3,394,425	July 30, 1968
Passafiume	6,119,303	Sep. 19, 2000

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Welt in view of Passafiume (Answer, page 3). Based on the totality of the record, we *affirm* the rejection on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

The examiner finds, and appellant does not dispute, that Welt discloses every limitation of claim 12 on appeal with the exception of a frame extending completely around the wiping surface (Answer, page 3; see the Brief, pages 4-6). The examiner applies Passafiume for the disclosure of a similar roller wiper/grid to that of Welt, where Passafiume teaches a frame extending completely around the wiping surface to support the grid (Answer, page 3). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellant's invention to have provided a frame surrounding the grid of Welt, as taught by Passafiume, to provide added rigidity to the grid (*id.*). We

agree.

Appellant argues that if one skilled in the art were to provide the device of Welt with a frame as taught by Passafiume, one would eliminate the laterally spaced feet 24,26 of Welt since the lower angled portions 54,56 of the frame 12 of Passafiume are intended for the same function, i.e., to abut the inner wall of the container 90 to prevent the grid 14 from pivoting or moving from its near vertical orientation as the roller 100 is rolled against the grid member 14 (Brief, page 5, citing col. 4, ll. 55-64, of Passafiume). Appellant further argues that providing Welt with a frame extending completely around the wiping surface would be directly contrary to the teachings of Welt, where Welt teaches that the arms and feet should be rotatable towards one another so that the device will require a minimum space for storage (*id.*). Appellant argues that neither reference discloses or suggests providing a pair of laterally spaced feet extending rearwardly from a bottom edge of a frame extending completely around the grid wiping surface as required by claim 12 on appeal (Brief, pages 5-6).

Appellant's arguments are not persuasive. The test for obviousness is not whether the entire apparatus or device of one reference may be bodily incorporated into another reference, but

what the combined disclosures and teachings of the references would have suggested to one of ordinary skill in the art. See *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991; *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981. Although the angled portions 54,56 disclosed by Passafiume accomplish a similar function as the feet of Welt (compare col. 4, ll. 55-64, of Passafiume with col. 1, ll. 44-45; col. 2, ll. 25-28, and ll. 40-45 of Welt), the examiner has only proposed incorporating the frame 12 from the device of Passafiume into the similar device of Welt for its intended benefit, i.e., to provide support and added rigidity for the grid wiping surface (Answer, pages 3-5). See Passafiume, col. 2, ll. 3-5; col. 3, ll. 30-34; and col. 4, ll. 10-11. As correctly noted by the examiner, the provision of such a frame around the structure of Welt need not eliminate the function or operability of the hooks and feet taught by Welt, as one of ordinary skill in this art "could easily provide a reinforcing frame around the grid of Welt without eliminating the movement of the hooks and feet of Welt" (Answer, page 5).

With regard to the rejection of claims 13 and 14, the examiner notes that claim 13 requires that the feet are "rigidly affixed" to the frame but concludes that rigidly affixed feet

would have been obvious to one of ordinary skill in this art "to match a common size" paint container if one did not need the rotating hooks/feet of Welt to accommodate different sized containers (Answer, pages 3-5). Appellant argues that the examiner's proposed modification ignores the teaching in Welt of rotatably securing the feet/hooks to the grid so that, when not in use, the feet and hooks may be rotated toward one another so that the device will occupy a minimum of space (Brief, page 6).

This argument is not persuasive. Omission of a feature with its corresponding loss of function would have been well within the ordinary skill in this art, i.e., eliminating the pivotable hooks and feet of Welt by making these hooks and feet fixed if the adjustable feature taught by Welt was unnecessary (if the device was only used on one size paint container; see col. 1, ll. 50-55, of Welt). *See In re Wilson*, 377 F.2d 1014, 1017, 153 USPQ 740, 742 (CCPA 1967); *In re Hamilton*, 404 F.2d 1388, 1390, 160 USPQ 199, 201 (CCPA 1969).

With regard to appellant's arguments concerning claims 14 and 16, we adopt the examiner's response on pages 5-6 of the Answer.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a prima facie case of

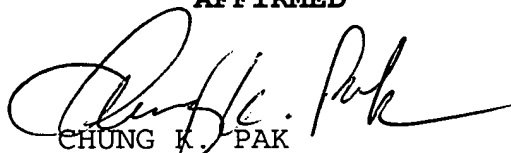
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obviousness based on the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the rejection of claims 12-14 and 16 under 35 U.S.C. § 103(a) over Welt in view of Passafiume.

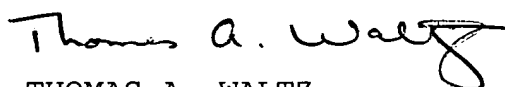
The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED



CHUNG K. PAK)
Administrative Patent Judge)



THOMAS A. WALTZ)
Administrative Patent Judge)



CATHERINE TIMM)
Administrative Patent Judge)

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